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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/685,737	10/11/2000	Shumpei Takenaka	35.C14864	3844
5514	7590	06/17/2004	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			PARK, CHAN S	
		ART UNIT	PAPER NUMBER	
		2622	DATE MAILED: 06/17/2004	

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/685,737	TAKENAKA ET AL.	
	<b>Examiner</b> CHAN S PARK	<b>Art Unit</b> 2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 11 October 2000.

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-14 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 1-14 is/are rejected.  
7)  Claim(s) 7 and 8 is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 11 October 2000 is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5.  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_.

***Claim Objections***

The following quotations of 37 CFR § 1.75(a) is the basis of objection:

(a) The specification must conclude with a claim particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention or discovery.

1. Claims 7 and 8 are objected to under 37 CFR § 1.75(a) as failing to particularly point out and distinctly claim the subject matter which the applicant as his invention or discovery. It is not clearly stated whether the claims are method claims or product claims. If the applicant is attempting to claim product claims the following preamble is suggested by Examiner to avoid U.S.C 101 rejection: "A computer program product encoding a computer program for executing image processing, wherein said computer program product executes steps of:"

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-11, 13 and 14 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Canon imageRUNNER 400/330 series manual (hereinafter Canon) which was published in 1998.

2. With respect to claims 1-4, Canon discloses an image processing apparatus (copier imageRUNNER 400/330) comprising:

designation means (PAPER SELECT KEY in page 2-22) for designating the image size of an image to be printed on a sheet (MEMO in page 3-20);

designation means for designating the number of images to be printed on a page (step 4 in page 3-22);

process means for executing a page change process (automatic copy reduction process) for each layout of the image size designated by said designation means (pages 3-20 and 3-21); and

printing means for printing an image (printing process by printer in pages 1-4 & 1-5).

3. With respect to claims 5 and 6, arguments analogous to those presented for claims 1 and 2, are applicable.

4. With respect to claim 7, Canon discloses a computer program product encoding a computer program for executing image processing, wherein said computer program product executes steps of:

storing the image size of images to be printed on a page, designated by designation means (MEMO in page 3-20);

executing a page change process for each layout of the image size designated by said storing step (pages 3-20 and 3-21).

The size selected by a user is inherently stored (presumably in RAM) since the apparatus remembers the paper size selected.

5. With respect to claim 8, Canon discloses a computer program product encoding a computer program for executing image processing, wherein said computer program product executes steps of:

storing the image size of images to be printed on a page, designated by designation means (MEMO in page 3-20 and page 3-23);

storing the number of images to be printed on a page, designated by designation means (step 4 in page 3-22); and

executing a process of layout of images on a page based on the image size or the number of images stored in either of the foregoing steps (pages 3-20 and 3-21).

6. With respect to claim 9, Canon discloses an image processing apparatus comprising:

image fetching means (scanning function in the copying mode) for fetching an image;

designation means for designating the size of the image to be printed on a sheet (MEMO in page 3-20 and page 3-23); and

memory control means for storing, in mutual correlation, the image fetched by said image fetching means and the image size designated by said designation means (pages 3-20 and 3-21).

7. With respect to claim 10, Canon discloses the image processing apparatus according to claim 9, wherein said image fetching means includes image pickup means for taking an image (scanner in the copier).

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8. With respect to claim 11, Canon discloses the image processing apparatus according to claim 10, wherein said image fetching means is adapted to fetch the image taken by said image pickup means through a memory medium (presumably in RAM).

Since multiple pages are combined in one page, pages that are scanned first must be saved in a memory while remaining pages are being scanned.

9. With respect to claim 13, Canon discloses an image processing apparatus comprising:

designation means for designating the image size of the image to be outputted (MEMO in page 3-20 and page 3-23); and

process means for executing a page change process for each layout with the image size designated by said designation means (pages 3-20 and 3-21).

10. With respect to claim 14, Canon discloses an image processing apparatus comprising:

means for receiving images with designated image sizes, to be printed on a sheet (MEMO in page 3-20 and page 3-23); and

means for executing layout of the said images and outputting said images, with the mutual correlation of the image fetched by said receiving means (scanner function or image data receiving function disclosed in page 1-5) and the designated image size (step 5 in page 3-23).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 5, 7, and 9-14 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Shiohara U.S. Patent No. 6,618,553.

11. With respect to claim 1, Shiohara discloses an image processing apparatus (digital camera 100) comprising:

designation means (print size specification means in figs. 6 & 7(b)) for designating the image size of an image to be printed on a sheet (col. 8, lines 3-6); and process means for executing a page change process for each layout of the image size designated by said designation means (fig. 8).

It should be noted that every image processing is processed within the camera before the data is transferred to a printer for printing. Thus, the digital camera 100 according to the user's selections inherently processes a page change process or an image process.

12. With respect to claims 5 and 7, arguments analogous to those presented for claim 1, are applicable.

13. With respect to claim 9, Shiohara Canon discloses an image processing apparatus (digital camera 100) comprising:

image fetching means (optical system 1 in conjunction with CCD 2 in fig 1) for fetching an image (col. 4, lines 1-6);

designation means for designating the size of the image to be printed on a sheet (print size specification means in figs. 6 & 7(b)); and

memory control means (recording medium control section 8) for storing, in mutual correlation, the image fetched by said image fetching means and the image size designated by said designation means (fig. 8).

14. With respect to claim 10, Shiohara discloses the image processing apparatus according to claim 9, wherein said image fetching means (optical system 1 in conjunction with CCD 2 in fig 1) includes image pickup means for taking an image (col. 4, lines 1-6).

15. With respect to claim 11, Shiohara discloses the image processing apparatus according to claim 10, wherein said image fetching means is adapted to fetch the image taken by said image pickup means through a memory medium (col. 5, lines 31-38).

16. With respect to claim 12, Shiohara discloses the image processing apparatus according to claim 11, wherein said memory medium is detachable (Compact flash in col. 4, lines 44-47).

17. With respect to claim 13, Shiohara discloses an image processing apparatus comprising:

designation means for designating the image size of the image to be outputted (print size specification means in figs. 6 & 7(b)); and

process means for executing a page change process for each layout with the image size designated by said designation means (fig. 8).

It should be noted that every image processing is processed within the camera before the data is transferred to a printer for printing. Thus, the digital camera 100 according to the user's selections inherently processes/executes a page change process or an image process.

18. With respect to claim 14, Shiohara discloses an image processing apparatus (digital camera 100) comprising:

means for receiving images with designated image sizes, to be printed on a sheet (print size specification means in figs. 6 & 7(b)); and

means for executing layout of the said images and outputting said images, with the mutual correlation of the image fetched by said receiving means (optical system 1 in conjunction with CCD 2 in fig 1) and the designated image size (fig. 8).

It should be noted that every image processing is processed within the camera before the data is transferred to a printer for printing. Thus, the digital camera 100 according to the user's selections inherently processes/executes a page change process or an image process.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Canon as applied to claim 11 above, and further in view of Miyahara U.S. Patent No. 5,878,197.

19. With respect to claim 12, Canon discloses the image processing apparatus according to claim 11 but it does not disclose expressly that the memory medium is detachable.

Miyahara discloses an image processing apparatus having a memory medium that is detachable (col. 4, lines 45-48).

Canon and Miyahara are analogous art because they are from the same field of endeavor that is the printing art.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the detachable memory unit of Miyahara with the image processing apparatus of Canon.

As it is commonly used in a conventional printer, the suggestion/motivation for doing so would have been to provide a portable memory unit that stores various image data.

Therefore, it would have been obvious to combine Canon and Miyáhara to obtain the invention as specified in claim 12.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S PARK whose telephone number is (703) 305-2448. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chan S. Park  
Examiner  
Art Unit 2622

csp  
June 4, 2004

  
EDWARD COLES  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600